

REMARKS

Applicant has amended claim 29 to remove unnecessary language from the preamble. No new matter has been added. Claims 29 and 67 remain for consideration in the application.

Claim Objections

Claim 29 was objected to for allegedly containing a limitation without antecedent basis. Applicant submits that there is clear antecedent basis for "the part" in line 8 of claim 29. Specifically, claim 29 recites "etching a second partial circumferential portion of said insulating layer *from a second partial circumferential part of said exterior surface* to expose the part of said exterior surface." It is clear from a reading of the claim language that "the part" in line 8 refers directly to the only other "part" recited in the claim, namely "a second circumferential part of said exterior surface." Therefore, there is clear antecedent basis for "the part" in line 8, and Applicant respectfully requests withdrawal of the objection.

Rejection Under 35 U.S.C. § 112

Claims 29 and 67 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant is at a loss as to why it is only now, after numerous detailed Office Actions, that such a rejection is brought up for the first time. If indeed the language was indefinite, Applicant would have expected that the rejection be raised some time ago, as this application has been pending in one form or another since August 31, 2000.

Applicant further submits that the Patent Office has apparently failed to take reasonable care in presenting its arguments and rejections. It is only now, after nearly three and one-half years of prosecution, that the Patent Office has chosen to bring up arguments that Applicant respectfully submits should have been brought up previously in one of the office actions, the current number of which is four, plus two additional advisory actions. Applicant continues to respond to the items the office brings up, but respectfully requests a complete action on the merits, identifying all issues. Applicant is spending valuable time and resources unnecessarily.

MPEP 706 recites in relevant part:

After the application has been read and the claimed invention understood, a prior art search for the claimed invention is made. With the results of the prior art search, including any references provided by the applicant, the patent application should be reviewed and analyzed in conjunction with the state of the prior art to determine whether the claims define a useful, novel, non-obvious, and enabled invention that has been clearly described in the specification. *The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.* The examiner then reviews all the evidence, including arguments and evidence responsive to any rejection before issuing the next Office action.

Applicant has been afforded no such courtesy. Each rejection adds new materials to the old rejections, several new searches have been made, and new rejections are still being entered in each new Office Action. Applicant now hopes that the newly presented remarks and amended claims will result in the end of prosecution and allowance and issuance of the current claims.

To respond specifically to the rejections, the Office Action asserts that the phrase "masking a first partial circumferential portion of said insulating layer; etching a second partial circumferential portion of said insulating layer" in claim 29 is not understood. Applicant does not know how to make such a statement more clear. The first clause describes masking one part of a circumferential portion of the insulating layer. Once that one part of the circumferential portion of the insulating layer is masked, a second portion of the insulating layer is etched. The plain language of the claim is clear. Similarly, the Office Action asserts that the phrase "masking a first portion of the insulating layer; etching a second portion of the insulating layer from a first region of the exterior surface to expose the first region of the exterior surface" in claim 67 is not understood. Once again, Applicant submits that the claim language is clear. The first and second portions of the insulating layer are as clearly described. [The first portion is masked, and the second, different portion, is etched. The plain language of the claim is clear.]

Accordingly, Applicant respectfully requests withdrawal of the rejections and allowance of the claims.

Rejection Under 35 U.S.C. § 103

Claims 29 and 67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dennison (U. S. Patent No. 5,362,666) in view of Dennison (U. S. Patent No. 6,331,725).

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Applicant strongly traverses this rejection. Applicant has repeatedly shown how Dennison is not applicable to the present claims. While the Patent Office continues to make new rejections, Applicant has continuously overcome the old rejections. Once again, the Office Action presents a flawed set of arguments rejecting the claims.

Specifically, The Office Action alleges that an "etch stop layer 30 is on a first partial circumferential portion of the insulating layer 32." This is incorrect. In fact, any etch stop layer 30 is on a full circumferential portion of the insulating layer. This layer 30 clearly completely surrounds the entire circumference of the insulating layer, as opposed to a "circumferential portion" of the insulating layer as recited in claim 29. It is clear from a reading of Dennison, specifically col. 10, and referring to Figs. 4-5, that the etch to remove the supporting insulator is done to a uniform depth on the entire circumference of the container, not on a partial circumferential portion as is recited in the claim. *See Baklanov, et al.* The Office Action seems to confuse circumferential with vertical. The recitation of claim 29 is to removal of a partial circumferential portion of the insulator. Dennison clearly shows a full circumferential removal of the insulator but for a portion of the vertical section. This is different than a partial circumferential removal as is recited in the claim. Dennison does not show each and every element of the claims. Nor is this element shown in Baklanov et al. or in any combination of Dennison and Baklanov et al.

Still further, the alleged mask layer of Baklanov et al. requires a complex, multi-step process to form a hard mask layer. See for example, col. 3, ll. 46-55, which requires the formation of a first layer, then a formation of a second layer on the first layer to etch the first layer before it is suitable for any use as a mask for yet another etching. These multiple steps introduce even more complexity into the present invention that are not needed. The process of the present claims is much simpler, requiring fewer steps, than any process of Baklanov et al. As such, no one would be motivated to introduce further complex steps into a process that already performs the same functions with fewer steps. Since no *prima facie* case has been made, claim 29 is allowable.

Claim 67 recites in part "etching a second portion of the insulating layer from a first region of the exterior surface to expose the first region of the exterior surface, such that the insulating layer remains in contact with an entire vertical height of a remaining region of the exterior surface." The Office Action alleges "that the insulating layer 32 remains in contact with

an entire vertical height of a remaining region of the exterior surface" (see page 4, paragraph 5). No support in the specification of Dennison or in the Figures thereof is made for such an assertion. In fact, there is no such support in Dennison. Referring to Figure 5 and col. 10, ll. 15-17, it is clear and unambiguous that the insulating layer 32 is removed from the complete circumferential portion of the exterior surface 48. In fact, the very lines the Office Action cites in support of the assertion are clearly in opposition to the assertion. They recite "a 'first etch process' etches through the film 32 *to stop completely on the etch stop layer 30.*" (col. 10, ll. 15-17). Nowhere in Dennison is it shown, described, discussed, or suggested, that the insulating layer remains in contact with an entire vertical height of a region of the exterior surface as is recited in claim 67.

Still further, the alleged mask layer of Baklanov et al. requires a complex, multi-step process to form a hard mask layer. See for example, col. 3, ll. 46-55, which requires the formation of a first layer, then a formation of a second layer on the first layer to etch the first layer before it is suitable for any use as a mask for yet another etching. These multiple steps introduce even more complexity into the present invention that are not needed. The process of the present claims is much simpler, requiring fewer steps, than any process of Baklanov et al. As such, no one would be motivated to introduce further complex steps into a process that already performs the same functions with fewer steps.

Dennison does not show each and every element of the claims. Nor is this element shown in Baklanov et al. or in any combination of Dennison and Baklanov et al. Since no *prima facie* case has been made, claim 67 is allowable.

CONCLUSION

In view of the above remarks, Applicant respectfully submits that all claims are in condition for allowance and requests reconsideration of the application and allowance of claims. The Examiner is invited to contact Applicant's attorney to discuss any questions that may remain with respect to the present application.

Respectfully submitted,

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